

REMARKS

Request for Reconsideration

Applicant has carefully considered the matters raised by the Examiner in the outstanding Office Action but remains of the position that patentable subject matter is present. Applicant respectfully requests reconsideration of the Examiner's position based on the above amendments to the claims, the attached Declaration of the Inventor and the following remarks.

Claim Status

Claims 1, 2, 4, 5, and 7-16 are pending in this Application.

Claim 1 has been amended to add the limitations of Claim 3 and Claim 3 has been cancelled. Claim 4 has been amended to add the limitations of Claim 6 and Claim 6 has been cancelled.

Respectfully, these amendments should be entered because the Examiner has already considered Claims 3 and 6 and, thus, amending Claims 1 and 4 to add the limitations of Claims 3 and 6, respectively, add no new matter. In fact, they reduce the issues in that it eliminates one of the rejections.

Respectfully, no new matter has been added by way of these amendments.

Prior Art Rejection

Claims 1, 4, and 7-14 had been rejected as being unpatentable over a combination of Chatterjee and Noguchi while Claims 2, 3, 5, 6, 15 and 16 have been rejected as being unpatentable over a combination Chatterjee, Noguchi and Owatari.

In light of the amendments made to Claims 1 and 4, it is respectfully submitted that the first rejection, based on the combination of Chatterjee and Noguchi, is now moot.

Turning to the second rejection, Applicant submits that it is not proper to combine the three references to arrive at the present Invention and that, even if combined, the combination does not work as in ink jet ink.

First, it is not proper to combine Chatterjee with Noguchi because Chatterjee is directed to non-aqueous based compositions while Noguchi is directed to aqueous based composition. Although Chatterjee discloses water as a possible component, Chatterjee is silent as to an aqueous based

ink composition which polymerizes by radical polymerization with an active ray. In fact, all of the examples of Chatterjee use organic solvents. None of the examples of Chatterjee use a water based composition. In fact, most of the components in Chatterjee's composition are hydrophobic and, thus, one of skill in the art would not make an aqueous ink using the teachings of Chatterjee. As will be noted, Claims 1 and 4, the independent claims herein, are directed to an aqueous ink and it is respectfully submitted that Chatterjee does not teach an aqueous based ink.

Second, Chatterjee teaches that the combination of Chatterjee with Noguchi will not work. The compositions of Chatterjee contain guanamine. Guanamine is a non-water soluble thermal setting resin which is generally used only with organic solvents as taught in Example 3 of Chatterjee. Therefore, it is submitted that Chatterjee teaches away from employing an aqueous based solution and, thus, one of skill in the art would not combine the teachings of Chatterjee and its non-aqueous composition with the aqueous polymerizable system of Noguchi.

Third, and most compelling, Applicant has made the UV curable formulation of Example 4 of Chatterjee and tested it to see if it would work as an ink that can be jetted. Applicant found that Chatterjee's composition won't jet because it is too viscous. Specifically, these tests are reported in the attached Declaration of Mr. Ishikawa. As can be seen by the attached Declaration, Mr. Ishikawa made the ink formulation of Example 4 and tested it. The material would not jet. In other words, it is unworkable as an ink jet ink. Respectfully, one of skill in the art would not look to the teachings of Chatterjee when trying to make a jetable ink composition because it is inoperative as a jetable ink composition, and the references on their face teach away from the combination.

Conclusion

In view of the foregoing and the enclosed, it is respectfully submitted that the Application is in condition for allowance and such action is respectfully requested. Should any extensions of time or fees be necessary in order to maintain this Application in pending condition, appropriate requests are

hereby made and authorization is given to debit Account # 02-2275.

Respectfully submitted,

LUCAS & MERCANTI, LLP

By: Donald C. Lucas
Donald C. Lucas, Reg. #31,275
Attorney for Applicant
475 Park Avenue South
New York, NY 10016
Tel. 212-661-8000

DCL/mr

Attached: Executed Declaration of Mr. Ishikawa signed on
June 20, 2007